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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,678	03/13/2001	Christopher Nathan Bell	41053/248772	3647

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EXAMINER	
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ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/805,678	BELL ET AL.	
	Examiner	Art Unit	
	Stephen Gravini	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *10 February 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20030210*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The specification is objected to because of the following informalities:

reference is made in the specification to a co-pending patent application, but the application number is not provided; and

computer executable hyperlink information is presented in the specification which is considered indefinite, because that information may not be the same when the application is published based on its filing date.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 11-13, and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Smolen (US 5,915,243). Smolen is considered to disclose the claimed system comprising:

a user system **101** adapted to monitor delivery of content from a separate content delivery entity, communicate user demographic information and user activity information to a separate integrating entity (column 3 line 58), and to enable a user to navigate at least part of said integrating entity, comprising:

a media player ancillary portion **103** adapted to receive, parse and report to a dispatching portion content activity information about content being delivered to a media player by said separate content delivery entity;

a dispatching portion **120** adapted to receive said content activity information and send at least part of said content activity information to said separate integrating entity; and

a command and control portion **130** adapted to run on at least the operating system of a user device and to allow the user to navigate at least part of the integrating entity; and

a separate integrating entity **140** adapted to receive user demographic information and content activity information from said user system, award incentives based on at least part of said content activity information, and enable users to redeem said incentives (column 7 lines 46-57 wherein the disclosed promotions is considered patentably equivalent to the claimed incentive redemption because both provide an redemption award for content activity). Smolen is considered to also disclose the claimed locally stored dispatch inability (column 6 lines 6-13), send user demographic information (column 6 lines 14-19), plug-in application (wherein the disclosed input device is considered patentably equivalent to the claimed plug-in application), user log on navigation (column 4 line 56), personal computer (column 3 line 59), set top box (column 3 line 47), media player implementation (column 5 line 47), other device implementation (column 5 line 48), content delivery entity implementation (column 4 line 26), fixed value incentives (column 3 line 30), award functionality adjustment content

characteristic (column 2 line 35), award functionality adjustment infrastructure characteristic (column 2 line 22), and award functionality adjustment demographic characteristic (column 2 line 51).

Claims 20-24, 28-34, 38-41, and 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Brien et al. (US 5,832,457). O'Brien is considered to disclose the claimed system and process comprising:

a user system **12** adapted to operate on a user device, which user device includes at least one content reception application, the user system including:

a monitoring computer program adapted to monitor delivery of content and generate content activity information based on content being delivered to said content reception application (column 5 lines 26-30);

a communications computer program adapted to receive at least part of said content activity information and sent at least part of said content activity information, coupled with demographic information related to the user of the user device, to a separate central system (column 5 lines 48-61); and

a coordination computer program adapted to enable the user to log onto said separate central system in order for at least part of said content activity information and user demographic information to be sent to said separate central system, and to enable the user to navigate at least part of said separate central system (column 5 line 62 through column 6 line 15); and

a central system located separately from said user system, adapted to receive, store and process at least part of said content activity information and user demographic information from said user system, and to award incentives selectively and variably based on characteristics of at least said content activity information (column 8 lines 4-66) or alternatively

a user system adapted to operate on a user device **10** , which user device includes at least one content reception application, the user system including:

monitoring means **13** for monitoring content being received by said content reception application and generating content activity information based on at least one characteristic of said content being received;

communication means **16** for sending at least pad of said content activity information to a separate central system; and

coordination means **20** for allowing the user to log on to said central system and to navigate at least pad of said central system in order to check status of incentives and to redeem at least pad of said incentives (wherein the disclosed personal computer implies log onto a central system because the disclosed purchase files discusses user access from a checkout dababase); and

a central system **24** located separately from said user system, comprising:

means for receiving, storing and processing at least part of said content activity information **26**, and for awarding incentives at least partially selectively and variably based on characteristics of at least said content activity information **28** or a process thereof. O'Brien is considered to also disclose the claimed media player plugin (column

5 line 27), tray application **21**, log on visual interface (column 8 line 11), personal computer (column 5 line 62), communication and coordination user device implementation (column 1 lines 23-32), communication and coordination other user device implementation (column 1 lines 24-42), and particular user incentives with a fixed value and related product information generation (column 6 lines 26-52).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smolen in view of Golden et al. (US 5,761,648). Smolen is considered to disclose the claimed invention as discussed above under the anticipatory rejection except for the claimed wireless device. Golden is considered to disclose the claimed wireless device at

column 1 lines 10-19. It would have been obvious to those skilled in the art to provide the wireless device to the teachings of Smolen for the purpose of communicating demographic and content activity information over a wireless communication channel.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smolen in view of Wolfe et al. (EP 0 847 156). Smolen is considered to disclose the claimed invention as discussed above under the anticipatory rejection except for the claimed parsed streaming audio. Wolfe is considered to disclose the claimed parsed streaming audio at column 3 lines 9-22. It would have been obvious to those skilled in the art to provide the parsed streaming audio to the teachings of Smolen for the purpose of communicating demographic and content activity information over a parsed streaming audio communication system or process.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smolen in view of Goldhaber et al. (WO 97/22074). Smolen is considered to disclose the claimed invention as discussed above under the anticipatory rejection except for the claimed auction. Goldhaber is considered to disclose the claimed auction from page 17 through page 22 wherein the disclosed attention brokerage functions in an equivalent manner as the claimed auction because both provide redemptive incentives for participating in advertisement viewing. It would have been obvious to those skilled in the art to provide the auction to the teachings of Smolen for the purpose of

communicating demographic and content activity information over a communication system or process in a redemptive competitive manner.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smolen in view of Cohen et al. (US 5,373,440). Smolen is considered to disclose the claimed invention as discussed above under the anticipatory rejection except for the claimed sweepstakes. Cohen is considered to disclose the claimed sweepstakes at column 1 lines 50-56. It would have been obvious to those skilled in the art to provide the sweepstakes to the teachings of Smolen for the purpose of communicating demographic and content activity information over a communication system or process in a redemptive game of chance intriguing manner.

Claim 25 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien in view of Smolen. O'Brien is considered to disclose the claimed invention as discussed above under the anticipatory rejection except for the claimed set top box. Smolen is considered to disclose the claimed set top box at column 3 line 47. It would have been obvious to those skilled in the art to provide the set top box to the teachings of O'Brien for the purpose of communicating demographic and content activity information over a communication system or process in a manner that would allow users an alternative communications means, such as television-type set top boxes.

Claim 26 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien in view of Golden et al. (US 5,761,648). O'Brien is considered to disclose the claimed invention as discussed above under the anticipatory rejection except for the claimed wireless device. Golden is considered to disclose the claimed wireless device at column 1 lines 10-19. It would have been obvious to those skilled in the art to provide the wireless device to the teachings of O'Brien for the purpose of communicating demographic and content activity information over a wireless communication channel.

Claim 27 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien in view of Wolfe et al. (EP 0 847 156). O'Brien is considered to disclose the claimed invention as discussed above under the anticipatory rejection except for the claimed parsed streaming audio. Wolfe is considered to disclose the claimed parsed streaming audio at column 3 lines 9-22. It would have been obvious to those skilled in the art to provide the parsed streaming audio to the teachings of O'Brien for the purpose of communicating demographic and content activity information over a parsed streaming audio communication system or process.

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien in view of Goldhaber et al. (WO 97/22074). O'Brien is considered to disclose the claimed invention as discussed above under the anticipatory rejection except for the claimed auction. Goldhaber is considered to disclose the claimed auction from page 17

through page 22 wherein the disclosed attention brokerage functions in an equivalent manner as the claimed auction because both provide redemptive incentives for participating in advertisement viewing. It would have been obvious to those skilled in the art to provide the auction to the teachings of O'Brien for the purpose of communicating demographic and content activity information over a communication system or process in a redemptive competitive manner.

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien in view of Cohen et al. (US 5,373,440). O'Brien is considered to disclose the claimed invention as discussed above under the anticipatory rejection except for the claimed sweepstakes. Cohen is considered to disclose the claimed sweepstakes at column 1 lines 50-56. It would have been obvious to those skilled in the art to provide the sweepstakes to the teachings of O'Brien for the purpose of communicating demographic and content activity information over a communication system or process in a redemptive game of chance intriguing manner.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable either over claims 1-63 of copending Application No. 09/766,504 or over claims 1-33 of copending Application No. 09/797,509. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention comprising a user system adapted to operate on a user device, which user device includes at least one content reception application, the user system including: a monitoring computer program adapted to monitor delivery of content and generate content activity information based on content being delivered to said content reception application; a communications computer program adapted to receive at least part of said content activity information and sent at least part of said content activity information, coupled with demographic information related to the user of the user device, to a separate central system and a coordination computer program adapted to enable the user to log onto said separate central system in order for at least part of said content activity information and user demographic information to be sent to said separate central system, and to enable the user to navigate at least part of said separate central system and a central system located separately from said user system, adapted to receive, store and process at least part of said content activity information and user demographic information from said user system, and to award incentives selectively and

variably based on characteristics of at least said content activity information or alternatively a user system adapted to operate on a user device, which user device includes at least one content reception application, the user system including: monitoring means for monitoring content being received by said content reception application and generating content activity information based on at least one characteristic of said content being received; communication means for sending at least pad of said content activity information to a separate central system; and coordination means for allowing the user to log on to said central system and to navigate at least pad of said central system in order to check status of incentives and to redeem at least pad of said incentives and a central system located separately from said user system, comprising: means for receiving, storing and processing at least part of said content activity information, and for awarding incentives at least partially selectively and variably based on characteristics of at least said content activity information or a process thereof is not considered patentably distinct from either the co-pending application comprising a platform for presenting a plurality of activities related to said content to users, said platform including a database for storing said content; a presentation/interaction functionality adapted to permit a user to input user demographic data and engage in said activities from said platform; and a processing functionality adapted to cooperate with said presentation/interaction functionality to store, process, and provide information to and receive information from said presentation/interaction functionality or comprising a platform for presenting a plurality of activities related to said content to users, said platform including a database for storing said content; a presentation/interaction

functionality adapted to allow said users to access content and engage in activities related to said content; and a processing functionality adapted to cooperate with said presentation/interaction functionality to store, process, and provide information to and receive information from said presentation/interaction functionality, said presentation/interaction functionality adapted to allow said content providers to access said content and view results of said activities engaged in by said users or providing a platform to users so that said users can access said content; providing said content and activities related to said content to said users; tracking said content consumed by said users and said activities engaged in by said users; and awarding users points for consuming content and engaging in activities related to said content because each of the pending applications provide systems and methods of incentive enabling and demographic generation with the obvious variation of using different claim recitations for performing the same purpose, using the same process or means, with the same result.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Reference U, cited in this action, is considered to be the most relevant non-patent literature reference with respect to the claimed invention.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is steve.gravini@uspto.gov. Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	**(703) 872-9327**
Official	**(703) 872-9306**
Non-Official/Draft	**(703) 872-9325**

STEPHEN GRAVINI
PRIMARY EXAMINER

smg
June 3, 2004